

Amendment and Response

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Serial No.: 10/028,616

Confirmation No.: 6755

Filed: December 21, 2001

For: METHODS FOR PLANARIZATION OF GROUP VIII METAL-CONTAINING SURFACES USING A
FIXED ABRASIVE ARTICLE**Remarks**

The Office Action mailed January 24, 2005 has been received and reviewed. Claims 1, 14, 24-27, and 42 having been amended, the pending claims are claims 1-33 and 35-42. Reconsideration and withdrawal of the rejections are respectfully requested.

The amended claims are fully supported by the originally filed specification, in particular: currently amended claims 1, 14, and 27 are supported, for example, by page 7, lines 4-15; currently amended claim 24 is supported, for example, by page 8, lines 1-13; currently amended claims 25 and 26 are supported, for example, by page 8, lines 10-13; and currently amended claim 42 is supported, for example, by page 8, lines 14-29.

The 35 U.S.C. §112, Second Paragraph, Rejection

The Examiner rejected claims 1-33 and 35-42 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner objected to the language "wherein the method results in reduced smearing and defect formation on the planarized surface compared to the same method and surface planarized with a fixed abrasive article comprising alumina or silica particles" on the basis that it "is improper to compare claimed material to material that is not claimed." This rejection is respectfully traversed.

It is noted that this language does not appear in claims 39-41. Thus, it is assumed that the incorporation of claims 39-41 in the list of claims rejected was in error.

Applicant's Representatives do not understand the rationale for the rejection, nor are they aware of the authority for the Examiner's statement. Applicant's Representatives have asked the Examiner for clarification and she deferred to her supervisory Examiner. Several attempts were made to set up an interview with both Examiners, but with no success.

Thus, please consider this a written request for such an interview to discuss this §112 rejection before issuance of another Office Action.

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It is respectfully submitted that this language is fully supported by the specification, for example, at page 7, lines 4-15. Furthermore, one of skill in the art would understand the meaning of the phrase "wherein the method results in reduced smearing and defect formation on the planarized surface compared to the same method and surface planarized with a fixed abrasive article comprising alumina or silica particles" and understand that the method using silica and alumina particles is not a part of the invention, but is the comparative method that demonstrates the unexpected properties of Applicants' claimed invention. There is no reason of which Applicants' Representatives are aware that prevent such language from being in a claim.

To clarify this language and expedite prosecution, claims 1, 14, and 27 have been amended to recite, "wherein the method results in reduced smearing and defect formation on the planarized surface compared to planarizing the substrate surface under the same conditions with a fixed abrasive article comprising alumina or silica particles instead of particles having a hardness of no greater than about 6.5 Mohs."

Furthermore, claims 24, 25, and 26 have been amended to remove this language and replace it with language similar to that in claim 39. Because claim 39 does not appear to have been rejected under § 112, these claims should also be in conformance with § 112.

Finally, claim 42 has been amended to recite, "wherein the method results in the selective removal of material from the Group VIII metal-containing surface having a nonplanar topography relative to an underlying oxide layer at a selectivity ratio of at least about 10:1," which is fully supported by the specification. It is respectfully submitted that this claim should be in conformance with § 112.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 1-33 and 35-38 under 35 U.S.C. §103 as being unpatentable over Russell et al. (U.S. Patent No. 6,395,194) as modified by James et al. (U.S.

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Patent No. 6,069,080), and further in view of Sachan et al. (WO 01/44396). This rejection is respectfully traversed.

It is noted with appreciation that claims 39-42 are free of this rejection. In view of the fact that claims 39-41 appear to have been inadvertently included in the list of claims rejected under § 112 (since they did not include the allegedly offensive language), and because claim 42 has been amended to remove such language, an indication of allowability of claims 39-42 is respectfully requested.

With respect to claims 1-33 and 35-38, it is respectfully submitted that the Examiner has used hindsight reconstruction by combining three documents in making the rejection. Furthermore, the Examiner's attention is directed to the language in each independent claim that refers to the unexpected results and the significant advantages of Applicant's claimed methods.

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).

It is submitted that there is no motivation to combine these three documents to provide Applicant's invention, which is directed to a unique combination of materials and steps (particularly when used on a nonplanar surface) that provide unexpected results. Even if there were such motivation, there is no reasonable expectation of success upon such combination.

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Furthermore, Applicant's Representatives respectfully submit that the combination of these three documents in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole,... was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S. P.Q. 2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Appellants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination nor suggests the reasonable likelihood that such a combination would result in the present methods having the significant results, particularly when applied to nonplanar surfaces.

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FIXED ABRASIVE ARTICLE**Summary**

It is respectfully submitted that the pending claims 1-33 and 35-42 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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April 21, 2005
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of April, 2005, at 2:17 pm (Central Time).

By: Sara E. OLSO
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